



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,970	04/27/2001	James Savoie	P-3032.01(UTI)	1652

7590 07/07/2003

Cline H. White
JACKSON WALKER, LLP
112 E. Pecan, Suit 2100
San Antonio, TX 78205

EXAMINER

NGUYEN, MERILYN P

ART UNIT	PAPER NUMBER
----------	--------------

2171

DATE MAILED: 07/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/844,970

Applicant(s)

SAVOIE ET AL.

Examiner

Merilyn P Nguyen

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,9-12 and 15 is/are rejected.
- 7) ☐ Claim(s) 3,4,7,8,13 and 14 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This application claims benefit of 60/200,784 filed on April 28, 2000.

1. Claims 1-16 are pending in this office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 contains the trademark/trade names FileMaker and FrameMaker at line 1 and 2. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade names are used to identify/describe commercial database and pagination program and, accordingly, the identification/description is indefinite.

Art Unit: 2171

Claim Objections

3. Claim 5 is objected to because of: at line 9, there is duplication of "to said pagination program".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

4. Claims 1, 5, 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Makipaa (US 6,556,217).

Art Unit: 2171

Regarding claim 1, Makipaa discloses a method for creating a computer file readable by a pagination program for generating an output (See Fig. 1 and 2), comprising:

- ❖ accessing a computer database (10, Figs. 1 and 2, and corresponding text, and col. 5, lines 22-28);
- ❖ identifying a record stored in said computer database (See col. 4, lines 58-67);
- ❖ adding a field directive to said record, wherein said field directive contains an instruction to said pagination program directing how said pagination program will format said output (See col. 7, lines 5-7);
- ❖ retrieving said record from said computer database (See col. 7, lines 17-41);
- ❖ adding computer code to said record to create said computer file, wherein said computer code makes said computer file readable by said pagination program (See col. 7, lines 42-45); and
- ❖ transferring said computer file to said pagination program where said output can be generated (See col. 7, lines 48-55).

Regarding claim 5, Makipaa discloses computer program having control logic stored therein, said control logic, when executed, enabling a computer to generate a computer file containing a record received from a computer database (See col. 7, lines 17-41), add a field directive to said computer file (See col. 7, lines 5-7), and convert said computer file to be compatible with a pagination program to develop an output (See col. 7, lines 42-45), said control logic comprising:

Art Unit: 2171

- ❖ accessing means for enabling said computer to access said record from said computer database (10, Figs. 1 and 2, and corresponding text, and col. 5, lines 22-28);
- ❖ coding means for identifying said record contained in said computer database (See col. 4, lines 58-67);
- ❖ coding means for adding at least one field directive, wherein said field directive provides an instruction to said pagination program directing how said pagination program will format said output (See col. 7, lines 5-7);
- ❖ coding means for converting said record into a computer file readable by said pagination program (See col. 7, lines 42-45); and
- ❖ coding means for transferring said computer file to said pagination program (See col. 7, lines 48-55).

Regarding claim 9, Makipaa discloses a method for converting at least two records stored in a computer database into a computer file readable by a pagination program, by:

- ❖ finding and retrieving a first record and a second record, each contained in said computer database (10, Figs. 1 and 2 and corresponding text, and col. 5, lines 22-28);
- ❖ adding a first field directive to said first record and a second field directive to said second record that will act as instructions to said pagination program to create a desired output (See col. 7, lines 5-7);

Art Unit: 2171

- ❖ analyzing said selected records to determine when said first record and said second record have been obtained from said computer database and generating said computer file from said records (See col. 5, lines 28-37);
- ❖ adding computer code to said computer file so as to make said computer file readable by said pagination program (See col. 7, lines 42-45); and
- ❖ transferring said computer file to said computer pagination program (See col. 7, lines 48-55).

Regarding claim 10, Makipaa discloses a computer-readable medium containing instructions for controlling a computer system for converting at least two records stored in a computer database into a computer file readable by a pagination program, by:

- ❖ using instructions in said computer readable medium to control said computer system to find and retrieve said records contained in said computer database to be converted into said computer file readable by said pagination program (10, Figs. 1 and 2 and corresponding text, and col. 5, lines 22-28);
- ❖ adding computer code to said records in order that said computer file will have a desired output (See col. 7, lines 42-45);
- ❖ generating said computer file from said records (See col. 5, lines 28-37);
- ❖ analyzing said selected records to determine when all said selected records have been obtained from said computer database (See col. 5, lines 28-37); and
- ❖ when it is determined all selected records have been obtained, exporting said computer file to said computer pagination program (See col. 7, lines 48-55).

Regarding claim 11, Makipaa discloses an article of manufacture comprising:
a computer useable medium having computer readable program code means embodied therein
for converting information stored in a computer database into a computer file readable by a
computer pagination program (See col. 7, lines 42-45), the computer readable program code
means in said article of manufacture comprising:

- ❖ computer readable program code means for causing the selection of the records
contained in said computer database to be converted (10, Figs. 1 and 2 and
corresponding text, and col. 5, lines 22-28);
- ❖ computer readable program code means for causing the sampling said computer
database a number of times to obtain said selected records (50, Fig. 2, and
corresponding text);
- ❖ computer readable program code means for causing the adding of computer code
to said records in order that said computer file will have a desired output (See col.
7, lines 42-45);
- ❖ computer readable program code means for causing the generation of said
computer file from said records (See col. 5, lines 28-37);
- ❖ computer readable program code means for causing the analyzing of said selected
records to determine when all said selected records have been obtained from said
computer database (See col. 5, lines 28-37); and
- ❖ computer readable program code means for causing the exportation of said
computer file to said computer pagination program (See col. 7, lines 48-55).

5. Claim 12 is rejected under 35 U.S.C. 102(e) as being anticipated by Sutcliffe (US 6,253,216).

Regarding claim 12, Sutcliffe discloses a method of converting a record of a first product stored in a computer database into a computer file readable by a pagination program (See col. 2, lines 44-53), comprising:

- ❖ controlling a computer system to create a file template (See col. 2, lines 55-61);
- ❖ controlling said computer program to select said record of said first product from among multiple product records stored in said computer database (See col. 7, lines 35-41);
- ❖ using said file template to add a field directive to said record of said first product, said field directive containing instructions used by said pagination program for formatting an output (See col. 7, lines 52-55);
- ❖ adding computer code to said record of said first product in order to create a computer file that is readable by said pagination program (144, Fig. 3, and col. 8, lines 9-12); and
- ❖ transferring said computer file to said pagination program (See Fig. 4, and corresponding text).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2171

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Makipaa (US 6,556,217), in view of Sutcliffe (US 6,253,216).

Regarding claim 2, Makipaa discloses all the claimed subject matter as set forth above in claim 1; however, Makipaa is silent as to identifying a first recipient of said output;

- ❖ obtaining said first recipient's address information;
- ❖ determining if said first recipient has a characteristic, said characteristic consisting of at least one of a bad account, a closed account, a competitor, a prior recipient, a non-orderer, or an undesirable physical location;
- ❖ terminating transfer of said output to said first recipient at said address if said first recipient has said characteristic; and
- ❖ transferring said output to said first recipient if said first recipient does not have said characteristic.

On the other hand, Sutcliffe discloses identifying a first recipient of said output (See col. 3, lines 64-65, Sutcliffe et al.);

- ❖ obtaining said first recipient's address information (See col. 4, lines 1-5, Sutcliffe et al.);
- ❖ determining if said first recipient has a characteristic, said characteristic consisting of at least one of a bad account, a closed account, a competitor, a prior

Art Unit: 2171

recipient, a non-orderer, or an undesirable physical location (See col. 10, lines 32-37);

- ❖ terminating transfer of said output to said first recipient at said address if said first recipient has said characteristic (166, Fig. 4, and corresponding text); and
- ❖ transferring said output to said first recipient if said first recipient does not have said characteristic (168, Fig. 4, and corresponding text).

Because Makipaa system having a pagination program to generate output to users, it would have been obvious to one having ordinary skill in the art at the time the invention was made to terminate transferring or permit transferring output from pagination program, as suggest by Sutcliffe, in term of security. Also, a claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Allowable Subject Matter

7. Claims 3, 7, and 13 are objected to as being dependent upon the rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 4, 8, and 14 depend on objected claims.

Claim 16 is allowed.

Regarding claim 16, the prior art of record fail to disclose or suggest the claimed steps of: creating a file template in conjunction with the remaining, salient claim provisions.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

De Heus U.S Patent No. 5,390,354 discloses computerized directory pagination system and method.

Warmus U.S Patent No. 6,332,149 discloses imposition process and apparatus for variable imaging system.

Rivette U.S Patent No. 6,018,749 discloses system, method, and computer program product for generating documents using pagination information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marilyn P Nguyen whose telephone number is 703-305-5177. The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Application/Control Number: 09/844,970

Page 12

Art Unit: 2171

Mn

MN

June 11, 2003

S. Metjahic
SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100